5

JUDGE WOODS

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

17 CV 4257

ROBERT G. LOPEZ, an individual,	)	
Plaintiff,	)	
v.	)	**Civil Action No.**
ONLY NY STORE LLC	)	**JURY TRIAL DEMANDED**
Defendant.	)	

FILED
U.S. DISTRICT COURT
2017 JUN -6 PM 4: 27
S.D. OF N.Y.

COMPLAINT FOR TRADEMARK INFRINGEMENT,
UNFAIR COMPETITION AND RELATED CLAIMS

Plaintiff, Robert G. Lopez, alleges his complaint against Defendant, Only NY Store LLC, as follows:

NATURE OF THE ACTION

1. This action arises from Defendant's infringement of Plaintiff's "ownership" and exclusive "use" rights in the marks, LOWER EAST SIDE™ and LES NYC®, in conjunction with clothing and related goods. Despite Plaintiff being the registered owner of the trademark LOWER EAST SIDE™ and LES NYC® and offering various clothing items under such brand names, the Defendant has infringed Plaintiff's rights in the aforementioned marks by promoting, selling, and offering for sale clothing items under Plaintiff's trademarks. Plaintiff has already experienced "actual confusion" in connection with this matter and is likely to continue to experience confusion as to the affiliation or connection between the Defendant and Plaintiff resulting in the unjust enrichment of Defendant by using Plaintiff's registered trademarks.

JURISDICTION AND VENUE

2. This Court has jurisdiction over this action pursuant to 15 U.S.C. §1051 *et seq.*, 15 U.S.C. Sections 1114-1116; under Section 43(a) of the Trademark Act, 15 U.S.C. §1125(a) and Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c).

3. This Court has personal jurisdiction over the Defendant because Defendant engages in continuous and significant business activities in, and directed to the State of New York within this judicial district and is registered with the NYS Department of State Division of Corporations to do business in New York and because Defendant has committed tortuous acts aimed at and causing harm within the State of New York and this judicial district.

4. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b) and (c) because it is where Plaintiff resides and the Defendant transacts business and/or maintains an office or business location in this district, and because a substantial portion of the events giving rise to the asserted claims have occurred, and continue to occur, within this district. Furthermore, the damage to Plaintiff and its intellectual property described herein continues to occur in this judicial district.

THE PARTIES

5. Plaintiff, Robert G. Lopez is an individual residing at 230 Clinton Street, Apt. #11C, New York, NY 10002.

6. Upon information and belief, Defendant Only NY Store, LLC is a New York Limited Liability Company with a principal place of business at 176 Stanton Street, New York, New York 10002.

FACTS

7. Since at least as early as 1999, Plaintiff Robert G. Lopez has been selling headwear, t-shirts, sweaters, hooded sweatshirts and other clothing items under the **LOWER EAST SIDE™** and **LES NYC®** brand names.

8. Since at least as early as 1999, Plaintiff has been independently operating a clothing business under the trade name **L.E.S. CLOTHING CO.™**, which has sold headwear, t-shirts, sweaters, hooded sweatshirts and other related clothing items under the marks **LES™**, **LOWER EAST SIDE™**, and **LES NYC®**. Since at least as early as 2010, Plaintiff has also been selling clothing items under the mark **LOYALTY EQUALS STRENGTH™** which is an additional representation of what the **LES™** acronym stands for and represents.

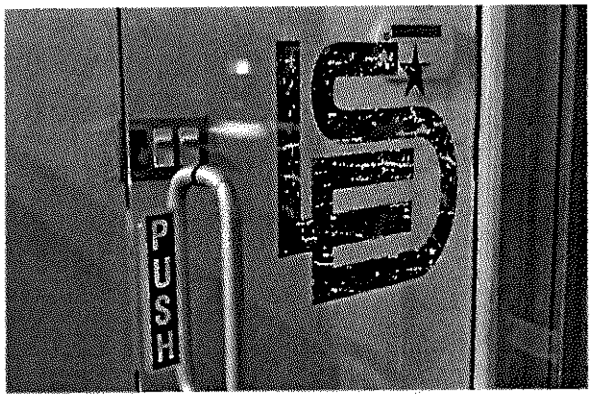
9. In addition to selling and offering for sale clothing items under the **LOWER EAST SIDE™**, **LES NYC®**, **LES™** and **LOYALTY EQUALS STRENGTH™** brand names, Plaintiff has also continuously sold and offered for sale various clothing items including hooded sweatshirts and t-shirts which bear the **THE LOWER™**, **LOWER EAST SIDE™** and **LES NYC®** marks in various font and design styles which are prominently displayed on the front and/or back of the headwear, t-shirts and/or sweaters as well as printed on hang tags, clothing labels, stickers and on clothing product packaging materials.

10. Plaintiff sells, and promotes the sale of his clothing via his website www.lesclothing.com, through flyer order forms, and his t-shirts, caps and other clothing items are also available for sale in several retail locations in New York City and other States. From 2012 to 2015 Plaintiff also maintained a Flagship LES Clothing Co. store located at 43 Clinton Street, New York, NY 10002, which is directly around the corner and only feet away from Defendant's store at 176 Stanton Street.

43 Clinton Street, New York, New York 10002

LES Clothing Co.™ Flagship Store (around the corner from Defendant's Only NY Store)

LES CLOTHING CO TM
Loyalty Equals Strength
43 Clinton Street New York, New York 10002
1 (800) 495-1539
www.lesclothing.com
www.facebook.com/lesclothingco



LES Clothing Co

ARMS
FUCKIN

11. Plaintiff advertises his **LES CLOTHING CO™**, **LOWER EAST SIDE™**, **THE LOWER™** and **LES NYC®** brands and clothing items through flyers, posters, stickers and through grass root street marketing methods such as painted "street murals." Plaintiff also regularly conducts photo shoots of customers who purchase his **LOWER EAST SIDE™** and **LES NYC®** related clothing items to be included in magazine advertisements and other marketing materials.

12. The **LOWER EAST SIDE™** brand and mark as used by Plaintiff has acquired "**secondary meaning**" in the marketplace in connection with the sale and offering of clothing goods based on Plaintiff's continuous and long standing use of the mark in the apparel industry.

13. Plaintiff and his **LES Clothing Co.™** company are the known source providers of **LOWER EAST SIDE™** and **LES NYC®** related clothing products, particularly in Lower Manhattan and in the area and vicinity in which Defendant's clothing store is located.

14. Plaintiff is the registered owner of New York State Trademark Registration No. R31067 and R32849 both for the mark **LOWER EAST SIDE™**. **(See Exhibit A).**

15. Plaintiff is the registered owner of United States Trademark Registration No. 4,549,880 for the mark **LES NYC®** which is the abbreviation and/or acronym for the mark **LOWER EAST SIDE NEW YORK CITY™**. **(See Exhibit B**).

16. The mark **LOWER EAST SIDE®** is a recognized clothing brand and is a federally registered trademark under United States Trademark Registration No. 2,416,437 that has been rendered "incontestable" under Section 15 of the Trademark Act and is therefore not open to challenge as to its function as a trademark and brand name as it has been in continuous use as a brand name in excess of fifteen (15) years. **(See Exhibit C).**

17. Plaintiff has a Co-Existence Agreement with Payless Shoesource Worldwide, Inc. who is the owner of United States Trademark Registration No. 2,416,437 for the mark **LOWER**

EAST SIDE®, which allows the parties to co-exist in the marketplace and both utilize the **LOWER EAST SIDE** mark but limits Payless's use of the mark to "**footwear**" and grants and/or limits Plaintiff's rights in the **LOWER EAST SIDE™** mark to "**t-shirts, sweaters, headwear**" and all other forms of clothing that exclude footwear.

18. Plaintiff is informed and believes and thereon alleges that Defendant is marketing, promoting, selling and offering for sale the t-shirt shown below bearing Plaintiff's **LOWER EAST SIDE™, and LES NYC®** marks.

Safari LTE
10:45 AM
45%
Instagram
onlyny
LOWER EAST SIDE
STANTON ST. SPORTS
NEW YORK CITY
618 likes
onlyny Memorial Day Weekend Sale - Last Day! 25% OFF online & in-store. Use code'Memorial25' at

19. Plaintiff was been contacted by several long-standing customer of his **LES CLOTHING CO™ LOWER EAST SIDE™** and **LES NYC®** clothing products regarding the **LOWER EAST SIDE™** t-shirt offered and sold at Defendant's Only NY Store located at 176 Stanton Street and from Defendant's website thinking the product was sponsored and/or affiliated with Plaintiff and his business LES Clothing Co.™

20. Defendant's use of Plaintiff's **LOWER EAST SIDE™** and/or **LES NYC®** brands in connection with clothing was done willfully as Defendant is aware of Plaintiff's brand

and clothing business as well as the existence of the LES Clothing Co. Flagship store and Defendant's use of Plaintiff's trademarks has already caused and will continue to cause confusion as to the source or affiliation of the source of the clothing related goods bearing the **LOWER EAST SIDE™** and **LES NYC®** marks.

FIRST CAUSE OF ACTION
TRADEMARK INFRINGEMENT (15 U.S.C. §§ 1114-1116)

21. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 20 of this Complaint.

22. The use in commerce by Defendant of an identical and slightly identical version of Plaintiff's registered trademark is likely to cause confusion, mistake and deception among members of the public and in trade as to the source, origin, or sponsorship of defendants' goods and services. Such use by defendant constitutes a clear and direct infringement of Plaintiff's rights in and to Plaintiff's registered trademark, and has resulted in injury and damage to Plaintiff that will continue if Defendant is not ordered to cease all use of the **LES NYC®** and **LOWER EAST SIDE™** marks.

SECOND CAUSE OF ACTION
UNFAIR COMPETITION & FALSE DESIGNATION OF ORIGIN (15 U.S.C. § 1125(a)

23. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 22 of this Complaint.

24. Plaintiff has the exclusive right to market, brand and provide clothing related goods using the **LES NYC®** and **LOWER EAST SIDE™** marks.

25. Defendant by reason of the aforementioned acts, have falsely described, represented and designated the origin of its goods and services. Defendants' activities already have confused the public into believing that Defendants and Plaintiff's clothing goods and

accessories come from one and the same source, and defendants continued activities are likely to create further confusion and deceive the public concerning the source of the goods/services.

26. Defendant have unfairly profited from the actions alleged herein and will continue to unfairly profit and become unjustly enriched unless and until such conduct is enjoined by this Court.

27. By reason of Defendant's willful acts conducted in conscious disregard for Plaintiff's rights, Plaintiff is entitled to treble damages under 15 U.S.C. § 1117(a).

THIRD CAUSE OF ACTION

COMMON LAW TRADEMARK INFRINGEMENT & UNFAIR COMPETITION

28. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 27 of this Complaint.

29. Defendant's conduct constitutes deception by which Defendant goods will be palmed off as those of Plaintiff. Such conduct constitutes trademark infringement and unfair competition in violation of the laws of the State of New York.

30. Defendant's unauthorized use of Plaintiff's **LOWER EAST SIDE™** and **LES NYC®** marks is likely to continue to cause further confusion to the public as to the clothing goods and accessories of the respective parties.

31. By reason of the foregoing, Defendant has infringed and continues to infringe on Plaintiff's common law rights in the **LOWER EAST SIDE™** and **LES NYC®** marks and Defendant has become unjustly enriched by such acts of infringement.

32. Defendant's unlawful conduct has been and will continue to be willful or willfully blind to Plaintiff's rights, as Defendant has reason to know of Plaintiff's rights.

FOURTH CAUSE OF ACTION

UNJUST ENRICHMENT

33. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 32 of this Complaint.

34. Defendant has unjustly retained profits from the sale of clothing goods and accessories bearing Plaintiff's **LOWER EAST SIDE™** and/or **LES NYC®** marks.

35. Defendant's actions constitute unjust enrichment.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully prays for relief as follows:

1. Entry of an order and judgment requiring that all defendant, its subsidiaries, officers, agents, servants, employees, owners, and representatives, and all other persons or entities in active concert or participation with them, be preliminarily and, thereafter, permanently enjoined and restrained from (a) using in any manner the trade name, trademark, domain name or other indicia or origin, including in whole or part the term **LOWER EAST SIDE™**, **LES NYC®**, or any colorable imitation thereof; (b) advertising, operating a website, using business stationary or offering any goods or services using the trade name, trademark, domain name, URL, or any other indicia of origin including in whole or part the term **LES NYC®**, or any colorable imitation thereof; (c) otherwise engaging in any acts of unfair competition and infringement which tend to injure Plaintiff's rights in the **LES NYC®** mark.

2. That Defendant be required to account to Plaintiff for any and all profits derived by it, and to compensate Plaintiff for all the damages sustained by reason of the acts complained of herein, and that the damages herein be trebled pursuant to the Trademark Act.

3. That Defendant be ordered to deliver up for destruction any and all infringing materials bearing the **LOWER EAST SIDE™** and **LES NYC®** marks, and any colorable imitation thereof, in whole or part.

4. That Plaintiff be awarded punitive damages.

5. That Defendant be required to place advertisements or send notifications to past and present customers that it improperly has been using the **LOWER EAST SIDE™** and/or **LES NYC®** marks.

6. That Plaintiff be awarded statutory damages in the amount of $1,000,000.00 for Defendant's acts of willful infringement.

7. That Plaintiff be awarded the cost and disbursements of this action.

8. That Plaintiff have such other and further relief as the Court deems just and proper.

JURY DEMAND

Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff hereby demands a trial by jury as to all issues.

Dated: June 6, 2017
New York, New York

Respectfully submitted,
Robert G. Lopez – Pro Se

Robert G. Lopez
Pro Se Plaintiff
230 Clinton Street – Apt. #11C
New York, New York 10002
(917) 868-1698

EXHIBIT A

New York State Department of State
Certificate of Trademark Registration

I Daniel E. Shapiro, Special Deputy Secretary of State, do certify that the Trademark described below and depicted on the attached copy has been duly registered in this Department pursuant to Article 24 of the General Business Law. This registration will remain in force for TEN years from the Date of Registration.

Registration Number:	R31067	*Registration Date:*	06/06/07
Applicant:	ROBERT G. LOPEZ 230 CLINTON STREET APT. #11C NEW YORK	NY 10002-	
State of Incorporation or Partnership Organization:			
Class Numbers:	25		
Date First Used in NYS:	12/1999	*Date First Used Anywhere*	12/1999

Trademark Description:

LOWER EAST SIDE

The mark is comprised of the words "Lower East Side" In stylized letters with an underline and overline.

Description of Goods: Clothing, namely, T-shirts, Hooded Sweatshirts, Vest, Hats and Caps as adopted from the USPTO.

WITNESS my hand and the seal of the State of New York In the City of Albany on this:

Thursday, August 16, 2007

by:

Special Deputy Secretary of State

DOS-690 (Rev. 3/01)

New York State Department of State
Certificate of Trademark Registration

I, Anthony Giardina, Executive Deputy Secretary of State, do certify that the Trademark described below and depicted on the attached copy has been duly registered in this Department pursuant to Article 24 of the General Business Law. This registration will remain in force for TEN years from the Date of Registration.

Registration Number: *R32849* **Registration Date:** *08/09/16*

Applicant: ***ROBERT G. LOPEZ***
230 CLINTON ST. - APT. 11C
NEW YORK NY 10002-

State of Incorporation or Partnership Organization:

Class Numbers: *25*

Date First Used in NYS: *12/01/1999* **Date First Used Anywhere:** *12/01/1999*

Trademark Description:
The mark is comprised of the words LOWER EAST SIDE without claim to any particular font, style or design.

Description of Goods: *Clothing, namely; t-shirts, sweaters, shorts and headwear.*

WITNESS my hand and the seal of the State of New York In the City of Albany on this:

Thursday, August 11, 2016

by:

Anthony Giardina

Executive Deputy Secretary of State

DOS-690 (Rev. 8/13)

EXHIBIT B

United States of America
United States Patent and Trademark Office

LES NYC

Reg. No. 4,549,880

Registered June 17, 2014

Int. Cl.: 25

TRADEMARK

PRINCIPAL REGISTER

LOPEZ, ROBERT G. (UNITED STATES INDIVIDUAL)
230 CLINTON STREET - APT. #11C
NEW YORK, NY 10002

FOR: BASEBALL CAPS AND HATS; HOODED SWEATSHIRTS; SHORT-SLEEVED OR LONG-SLEEVED T-SHIRTS; T-SHIRTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 12-0-1999; IN COMMERCE 12-0-1999.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SEC. 2(F).

SER. NO. 85-335,314, FILED 6-1-2011.

ALICE BENMAMAN, EXAMINING ATTORNEY

UNITED STATES PATENT AND TRADEMARK OFFICE
DEPARTMENT OF COMMERCE

Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

EXHIBIT C

United States Patent and Trademark Office

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Fri Jun 2 02:21:45 EDT 2017

TESS HOME | NEW USER | STRUCTURED | FREE FORM | BROWSE DICT | SEARCH OG | BOTTOM | HELP | PREV LIST | CURR LIST | NEXT LIST | FIRST DOC | PREV DOC | NEXT DOC | LAST DOC

Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **Record 26 out of 29**

TSDR | ASSIGN Status | TTAB Status *(Use the "Back" button of the Internet Browser to return to TESS)*

LOWER EAST SIDE

Word Mark	LOWER EAST SIDE
Goods and Services	IC 025. US 022 039. G & S: Footwear. FIRST USE: 19990616. FIRST USE IN COMMERCE: 19990616
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75652553
Filing Date	March 3, 1999
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	November 30, 1999
Registration Number	2416437
International Registration Number	1220106
Registration Date	December 26, 2000
Owner	(REGISTRANT) PAYLESS SHOESOURCE WORLDWIDE, INC. CORPORATION KANSAS Jayhawk Towers 700 SW Jackson Topeka KANSAS 66603
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	ROBERT CARROLL
Prior Registrations	1795922
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20110108.
Renewal	1ST RENEWAL 20110108